PATENT
251.82B
(0409.86NUS2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
	)	
ULRICH ANNEN, ET AL.	)	Group Art Unit:
	)	
Serial No.: Not Yet Assigned	)	Examiner:
	)	
Filed: Herewith	)	Paper No.: 12
	)	
Title: N-ALKYL AMMONIUM ACETONITRILE SALTS, METHOD THEREFOR AND COMPOSITIONS THEREWITH	)	Prior Group Art Unit: 1714 Prior Examiner: J.D. Anthony

Oakland, California 94623
May 3, 2001

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Date: May 3, 2001

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PRELIMINARY AMENDMENT
37 C.F.R. §1.111

Dear Sir:

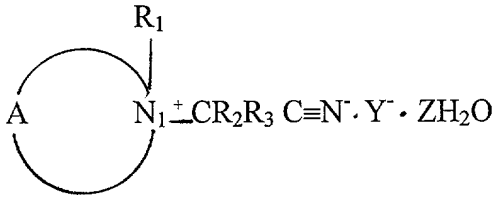
Prior to a first Action on the merits, Applicant respond as follows:

IN THE CLAIMS

Kindly amend the Claims as follows:

--1. (Thrice Amended) A substantially solid composition comprising:
a compound having the structure of Formula I

FORMULA I



wherein A is a saturated ring formed by a plurality of atoms in addition to the N_1 atom, the saturated ring atoms including at least one carbon and at least one heteroatom in addition to the said N_1 atom, the said at least one heteroatom selected from the group consisting of O, S and N atoms, the substituent R_1 bound to the N_1 atom of the Formula I structure is (a) a C_{1-8} alkyl or alkoxylated alkyl where the alkoxy is C_{2-4}, (b) a C_{4-24} cycloalkyl, (c) a C_{7-24} alkylaryl, (d) a repeating or nonrepeating alkoxy or alkoxylated alcohol, where the alkoxy unit is C_{2-4}, or (e) $-CR'_2R'_2R'_3C{\equiv}N$ where R'_2 and R'_3, are each H, a C_{1-24} alkyl, cycloalkyl, or alkylaryl, or a repeating or nonrepeating alkoxyl or alkoxylated alcohol where the alkoxy unit is C_{2-4}, the R_2 and R_3 substituents are each H, a C_{1-24} alkyl, cycloalkyl, or alkylaryl, or a repeating or nonrepeating alkoxyl or alkoxylated alcohol where the alkoxy unit is C_{2-4}, Z is in the range of 0 to 10 and wherein Y is monovalent or multivalent and is sulfate, bisulfate, tosylate, or mixtures of sulfate and bisulfate as counterion, the Formula I compound capable of reacting with a peroxygen source in alkaline solutions, and a bleaching and/or cleaning adjunct carried by, coated with, or admixed with the compound.

In Claim 34, line 1, kindly delete "10" and insert --1--.

REMARKS

This response is submitted in lieu of a response to Office Action dated November 3, 2000, in the Parent Application (Serial No. 09/163,723, filed 09/30/98). A copy of an extension of time of three months (Paper No. 13) in the Parent is also included. In Appendix I is a clean copy of the claims including any amendments (37 CFR §1.121).

1. Status of the Claims

The action in the Parent was very thorough and resulted in the allowance of no claims, although all claims were found free of prior art. Claims 1-9 and 34-36 were rejected there for alleged indefiniteness. Finally, all claims were rejected there for alleged obviousness-type double patenting, provisionally, over U.S. Patent Application 09/280,178 (now U.S. Patent 6,183,665), and non-provisionally, over U.S. Patents 5,888,419, 5,741,437, 5,739,327, and 5,959,104.

4. Indefiniteness Rejection

The action in the Parent rejected Claims 1-9 and 34-36 for indefiniteness. Per the Examiner's helpful suggestions in the Parent Office Action, Claims 1 and 34 were appropriately amended and should be allowable. Claims 1-9 and 35-36 depend, respectively, from Claims 1 and 34, and should similarly now be allowable.

7. Alleged Double Patenting

Claims 1-11 were also rejected in the Parent as allegedly violative of the judicially created doctrine of obviousness-type double patenting over the Claims 1-24 of co-pending Serial No.09/280,178 (now U.S. Patent 6,183,665).

The claims were also non-provisionally rejected over issued U.S. Patents 5,958,289, (Claims 1-5) 5,888,419 (1-16), 5,741,437 (4-26), 5,739,327 (1-12) and 5,959,104 (1).

In this continuation, Applicants take the rejections as being over all of these patents (including U.S. Patent 6,183,665) for non-provisional double-patenting. All of these rejections are believed inappropriate and unnecessary.

First, the law of double-patenting explicitly notes that to reject claims, the second case's claimed invention is an obvious modification, or mere variation, of the claimed invention in the first case. In re Goodmen, 29 USPQ2d 2010 (Fed. Cir. 1993). Absent this test, there is no double-patenting. In addition, all of the references here have filing dates contemporaneous to either this application's earliest priority date (November 29, 1996), and relate back to the earliest priority ancestor Serial No. 08/475,292 (now U.S. Patent 5,739,327). But none of these references claims the salts (Claims 1-9 and 31-33), composition (Claims 10-19, 20-30) or process (Claims 34-36) in which either a sulfate, bisulfate, tosylate, or mixtures of sulfate and bisulfate are present. This factual difference obviates the rejection.

There is lastly a policy reason for removing the rejection. As is known, the Uruguay Rounds Act of the General Agreement on Tariff and Trade (the "URA" and the "GATT", respectively), amended 35 U.S.C. §154, providing that patent terms for cases filed after June 8, 1995, would receive a term of no more than twenty years from the earliest patent application upon which the patent application at bar had relied on under 35 USC 120, 121 or 365(c).

Clearly, the goals of the URA and the double patenting-obviousness type are in conflict. Since the URA already requires essentially simultaneous expiration as the earliest -to- expire patent (U.S. 5,739,327), then the rationale for the obviousness-type double patenting policy is rendered ineffective and is merely an additional burden on Applicant.

It is therefore submitted that the obviousness-type double patenting rejection is overcome, factually, and on policy grounds.

CONCLUSION

As a result of the foregoing amendments to the specification and claims, it is respectfully submitted that allowable subject matter has been defined and claimed. Favorable consideration is courteously urged. If the next action is other than to allow the claims, the favor of a brief telephone interview is requested.

Respectfully submitted,

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